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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,681	09/18/2003	Leonard Robert Speiser	2043.093US1	8255

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SCHWEGMAN, LUNDBERG & WOESSNER/EBAY
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MINNEAPOLIS, MN 55402

EXAMINER

SHEIKH, ASFAND M

ART UNIT	PAPER NUMBER
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3627

NOTIFICATION DATE	DELIVERY MODE
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07/15/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@SLWIP.COM

Office Action Summary	Application No.	Applicant(s)	
	10/666,681	SPEISER ET AL.	
	Examiner	Art Unit	
	Asfand M. Sheikh	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/5/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 6/5/2009 was filed after the mailing date of the Examiner's Answer on 12/11/2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Response to Arguments

The examiner has reproduced the response as found in the Examiner's Answer with respect to the arguments presented in the Appellant's Appeal Brief.

Claims 15-22 are unpatentable under 35 U.S.C. 102(a) for being anticipated by Spiegel et al. (US 6,466,918).

Regarding the argument that Spiegel et al. fail to disclose "identifying at least one frequently used search term associated with the identified division," Spiegel et al. indeed disclose "identifying at least one frequently used search term associated with the identified division," for example, the frequently-used search term "Olympics" associated with the second identified division under "Featured Categories" in Figure 1. See, in particular, column 7, lines 6-67. Note that, although all claims have been interpreted in light of the specification, limitations from the specification have not been read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding the argument that Spiegel et al. fail to disclose "providing a link to the user to listings associated with the at least one frequently used search term," Spiegel et al. indeed disclose "providing a link to the user to listings associated with the at least one frequently used search term," since the items/listings shown in Figure 1 are hyperlinks. See, in particular, column 4, lines 61-67. Note that, although all claims have been interpreted in light of the specification, limitations from the specification have not been read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

To the extent that appellant is arguing that the references applied in the rejection fail to use the same names/words for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

To the extent that appellant is arguing that the disclosure in the applied prior art is not in as complete detail as is recited by the instant claims, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings *in combination with his own knowledge* of the particular art and be in possession of the invention. See *In re Graves*, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980); *In re Samour*, 197 USPQ 1 (CCPA 1978).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 15-22 are rejected under 35 U.S.C. 102(a) as being anticipated by Spiegel et al. (US 6,466,918).

Spiegel et al. disclose a method of providing listing recommendations to users of a network-based commerce system including a plurality of listings 120 arranged in a plurality of divisions 130, the method including: identifying a division 110 of the plurality of divisions 130 based on user interaction with the network-based commerce system; identifying at least one frequently used search term associated with the identified division 110; and providing a link to the user to listings 120 associated with each frequently used search term 110. See, in particular: col. 4, lines 43-67; col. 6, lines 5-60; col. 7, lines 6-67; col. 8, lines 33-59; and, Figure 1A.

Regarding claim 16, the method of Spiegel et al. includes communicating a web page to the user including a hyperlink to the listings associated with each frequently used search term. See, in particular, column 4, lines 61-65.

Regarding claim 17, in the method of Spiegel et al. the listings associated with each frequently used search term are listings that would be located if the user

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conducted a search of the network-based commerce system using each frequently used search term.

Regarding claim 18, in the method of Spiegel et al. the at least one frequently used search term is ranked in one of an ascending and descending order according to a number of occurrences of listings in a division associated with the at least one frequently used search term.

Regarding claim 19, the method of Spiegel et al. inherently includes periodically adding new listings and removing terminated listings prior to determining the number of listings in each division associated with each frequently used search term so that the ranking is dependent upon supply and demand for the listings.

Regarding claim 20, the method of Spiegel et al. includes searching the network-based commerce system using at least one frequently used search term when the user selects the link.

Regarding claim 21, in the method of Spiegel et al. the at least one frequently used search term is displayed according to rank in one of an ascending and descending order.

Regarding claim 22, in the method of Spiegel et al. one or more frequently used search terms are assigned to each of the plurality of divisions, the divisions being defined by categories.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asfand M. Sheikh whose telephone number is (571)272-1466. The examiner can normally be reached on 9a-5p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan M. Zeender can be reached on (571)272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Asfand M. Sheikh/
Examiner, Art Unit 3627
9 July 2009

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627